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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,425	03/09/2001	Dean Rhoades	05309P001X	7222

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EXAMINER

CHOI, FRANK I

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 09/802,425	Applicant(s) RHOADES, DEAN	
	Examiner Frank I. Choi	Art Unit 1616	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 15 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): Rejection of claims 1-3,5,7,21,22 under 102/103 over Wise.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-3,5,7 and 21-23.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

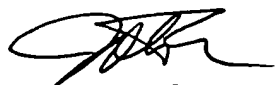
#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 3/8/2005  
13. ☐ Other: \_\_\_\_\_.



  
FRANK I. CHOI  
PRIMARY EXAMINER  
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Continuation of 11. does NOT place the application in condition for allowance because: Examiner has duly considered Applicant's arguments but deems them unpersuasive for the reasons set forth in the prior Office Action and the further reasons below. Based on Applicant's arguments, Applicant acknowledges that a moisturizer can be a mixture of components which may include components which act as a barrier or draws moisture. Examiner, therefore, concedes that for purposes of the claimed invention, a moisturizer is defined as above and withdraws the written description rejection with respect to the same. With respect to the limitations of "at least about twenty three percent by weight moisturizer" and "at least thirty five percent by weight" of the corundum, again, none of Applicant's cited disclosure supports the range as claimed. As indicated in the prior Office Action, Wertheim (I) at pg. 97 is directly on point. The claimed ranges read literally on embodiments outside of the ranges described in the application, as such, the claim limitations constitute new matter. Further, contrary to Applicant's arguments, the facts in Wertheim (I) are simply not applicable to the facts in the present Application in that in Wertheim (I) there was a basis for the amended range. In this case, there is no basis for choosing "124 microns". Applicant argues that Wertheim (II) is not applicable, however, priority is directly related to 35 USC 112, 1st paragraph. In order for there to be priority the disclosure in the child application must supported by the disclosure in the parent application in the manner provided by the first paragraph of section 112. See 35 USC 120. As such, in view of Wertheim (II), there is a distinction between the prior broad range and the narrower range now claimed. As such, the end point of "124 microns" constitutes new matter. With respect to the limitation "about", Applicant's arguments do not provide any evidence as to what amounts would and would not be included in the term "about". Applicant cites to a range of 20-70% aloe which would appear to include the prior art disclosure of "about 20%", yet, Applicant argues that the amended range excludes "about 20%". This renders the claims indefinite. With respect to Messenger, Examiner concedes that Messenger does not claim the "same" invention. However, Applicant's affidavit states that the moisturizer ingredients are twenty percent by weight of the base. There is no indication as to how Applicant arrived at 20% by weight as none of the components individually equal 20%. Further, claims 1-3, 21-23 do not recite 20% but "at least about twenty three percent" and the amount of corundum is 50% not "at least 35%" as is in claims 5, 7. As such, Applicant's affidavit fails to establish reduction to practice of the claimed invention. See *In re Tanczyn*, 146 USPQ 298 (CCPA 1965). Further, with respect to claims 1-3, 5, 7, 21-23 the affidavit is not commensurate in scope to the extent the claimed invention is shown in the Messenger reference in that the affidavit indicates 20% of moisturizer, 50% of 120 micron aluminum oxide whereas Messenger discloses 40% of about 125 micron corundum and 56% mineral oil. See *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970). As such, the affidavit is insufficient to overcome the rejection over Messenger. With respect to Lee, contrary to Applicant's arguments, as set forth in the prior Office Action, Examiner has provided evidence that water provides moisture. Applicant acknowledges that a moisturizer may include a mixture of components. Applicant's definition of "moisturizer" is open ended and, thus, while it may include components which act as a barrier or attract moisture, it is not limited to the same. Further, Applicant has provided no evidence that the term "moisturizer" excludes a mixture of components which includes water. As such, the water plus the other components, such as surfactants, hectorite and/or xanthan gum appears to fall within the scope of the term moisturizer. With respect to the limitation "where the composition may be left on the skin after application" regardless of whether the limitation is an intended use or property, the burden is still on Applicant to show that the prior art composition is incapable of being left on the skin after application. With respect to Saperstein or Steifel, Examiner maintains the rejection for the same reasons as discussed for Lee. With respect to Immura, contrary to Applicant's arguments, Examiner has provided the plain meaning of the term "cream" as set forth in the prior Office Action and, as such, the prior art composition disclosed in Immura appears to fall within the scope of the limitation "cream". With respect to Wise, Examiner withdraws the rejection. With respect to McAtee, contrary to Applicant's arguments, Examiner has not acknowledged that the phrase "about 23%" distinguishes McAtee. Examiner only indicated that Applicant has argued that the phrase "about 23%" distinguishes McAtee. This hardly constitutes an acknowledgment that the amendment distinguishes McAtee. Applicant's argument provides no evidence that "about" excludes "about 20%". With respect, to Wdowik, as indicated above, with respect to Lee, Saperstein and Steifel, Applicant has made no showing that term "moisturizer" cannot include a mixture of components which includes water. Although Applicant has provided no evidence that water is excluded from the term moisturizer, Applicant arguments, even if valid with respect to water alone being a moisturizer, fail to overcome the rejection as said arguments fail to address a mixture of components, in which one of the components is water, as falling within the scope of the term "moisturizer". With respect to claim 21, again the burden is on Applicant to show that the prior art composition cannot be left on the skin notwithstanding that disclosure in Wdowik that the shaving composition is intended to be removed with for example by a razor. Applicant's own Specification discloses nothing about leaving the entire composition on the skin. According to the Specification, the user wipes off any unabsorbed portion of the composition, as such, the composition in its entirety is not left on the skin (Specification, paragraph 0032). Further, the claim does not specify any time limit, as such, a composition which is left on the skin until such time as it is shaved off would appear to meet said limitation. With respect to the rejection of McLaughlin in view of Wdowik, Applicant's citation to specific examples as not yielding the claimed invention is insufficient to overcome the rejection. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In *re Susi*, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In *re Gurley*, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). With respect to claim 21, Applicant has provided no evidence that the composition may not be left on the skin and has not set forth any minimum or maximum time limit for leaving the composition on the skin. In fact, Applicant's Specification indicates that any unabsorbed portion of the claimed composition is wiped off. As such, application of the shaving cream and subsequent shaving appears to meet the claim limitation. With respect to claim 5, the passage quoted by Applicant does not indicate that shaving creams cannot have greater than 20% of the particulate additive only that in thick pastes, solids and gels as high as 90% or greater of the particulate additive can be used. As indicated above, preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments.